

In re Application of: Ron HILLELY
Serial No.: 10/553,631
Filed: October 19, 2005
Office Action Mailing Date: May 11, 2009

Examiner: Jaymi E. DELLA
Group Art Unit: 4137
Attorney Docket: 30669

REMARKS

Reconsideration of the above-identified Application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-70 are pending in the Application. Claims 1 and 37 have been previously amended in order to broaden those claims.

Claim 33 has been allowed, if rewritten as an independent claim. Claims 1-32 and 34-70 have been rejected.

By this response, claims 1, 31, 37, and 68 have been amended.

Specification

The Examiner has objected to the disclosure because of informalities on page 1 and on page 12, and requested appropriate references to trademarked names DELRIN® and TEFLON®. These matters have been handled by the amendments to the specification detailed above.

Drawings

The Examiner has objected to the drawings under 37 C.F.R. §1.83(a) because they fail to show "cryoprobes 290" as described in the specification on page 25, line 30. A replacement sheet for Figure 11 (drawing sheet 9/9) has been provided, wherein additional labels have been provided in the figure to add clarity to the disclosure, and the text on page 25 has been amended, also to add clarity. No new material has been presented. In the original Figure 11 one of the probes was labeled as a therapeutic probe 280. Cryoprobes 290 are identified in the specification on page 24 line 4 as an optional embodiment of therapeutic probes 280, and the text cited by the Examiner on page 25 identifies the probes in the figure as cryoprobes. In amended figure 11 and the amended text each probe of figure 11 has now been labeled appropriately.

The Examiner further states that the drawings fail to show "circular markings" of claims 31 and 68. Applicant requests to draw the Examiner's attention to figure 9, which clearly shows the circular markings, one of which is labeled 292. The circular markings designated by label 292 are defined and explained starting on page 24, line 30.

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With respect to the objection to poor line quality and solid black shading, the Examiner's attention is drawn to the fact that figures 7 and 9-11 are actually photographs which have been adapted for use in the specification by the addition of identifying labels, and have been identified as such in the specification.

Claim Rejections – 35 U.S.C. §112

The Examiner has rejected claims 31 and 68 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because of use in both claims of the undefined term "under standardized conditions". Claims 31 and 68 have been amended and the words "under standardized conditions" have been removed.

Claim Rejections – 35 U.S.C. §101

The Examiner has rejected claims 37-70 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter, because the claims positively recite a part of the human body. Claims 37 and 68 as currently amended do not recite a part of the human body.

Claim Rejections – 35 U.S.C. §102

The Examiner has rejected claims 1-6, 11-12, 16-24, 25-29, 34, 37-40, 42-44, 49-50, 53-64, 66, and 69 under 35 U.S.C. §102(b) as being anticipated by Downey et al in U.S. Patent No. 6,206,832. In response to the Examiner's "note to Applicant" stating that original claim 1 does not require positively any sequence of steps, claim 1 has been amended so as not to read on a process whereby original steps (a) and (b) are performed simultaneously. Amended claim 1 consequently does not read on Downey's apparatus and method, and therefore claim 1 and claims dependent thereon should be found patentable over the cited art.

Similarly claim 37 has been amended and now makes explicit that the template is independent of the orientation probe and is capable of being rigidly affixed thereto after the orientation probe is inserted and positioned with respect to the treatment target. Thus claim 37 as currently amended also clearly does not read on Downey's

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invention, consequently claim 37 and claims dependent thereon should now be found to be in state of allowance.

The Examiner further rejects claims 37, 47-49, 53-58, 63 and 69-70 as being anticipated by West et al (U.S. Patent No. Des 260,727). Applicant submits, however, that West's design is inappropriate for use "for guiding a therapeutic probe to a treatment target", because West's design does not comprise a "probe guide operable to constrain movement of a therapeutic probe inserted therethrough in such a manner that" (if the orientation probe is positioned as stated in the claim and) the template is "rigidly affixed" to the orientation probe, would constrain the therapeutic probe to move towards the target. We note in passing that West's probe contains no two holes of a same size and so would not be useable with any existing sets multiple cryoprobes. More important, the pressure arrangement which might be used to affix his clamp to an orientation probe also affects pressure applied to any additional probes passed through additional holes of the device. So, first of all, for an orientation probe and a therapeutic probe of the same size, no two holes could be found where one of the probes could be "rigidly affixed" while movement of a second probe through its hole could be accurately constrained to pass through in a controlled direction. Secondly, even if a pair of probes had different sizes and could thereby be held within differing holes of West's device, there is no planned nor necessarily appropriate relationship between the amount of pressure applied to a probe needing to be "rigidly affixed", and that applied to a second probe needing to be accurately guided in a specific direction, but also needing to be free to move forward and backward within the guiding hole while being accurately prevented (to exacting therapeutic medical standards) from straying off course in a somewhat sideways direction. In other words, West's device, while superficially similar to the device presented in the instant application, cannot in fact be used for the same purpose, nor does it suggest nor make obvious a device which could be so used. West's device should be contrasted to the device of the instant invention, where pressure clamping is applied to a single probe, the orientation probe, while a plurality probe guides are accurately sized and shaped so as both to enable easy movement of therapeutic probes therethrough and to accurately constrain the direction of the movement of those probes. West's device, with pressure applied

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to all holes from the same pressure source, clearly could not be used for guiding a therapeutic probe to a treatment target in any practical way.

The Examiner also rejects claims 37, 47-49, 53-58, 63 and 69-70 as being anticipated by Zurinski et al. (U.S. Patent No. 4,542,747). However, Zurinski's guide channels 50, 52, and 54 cannot be used as described in claim 37 for much the same reasons that West's design cannot. Zurinski's guide channels 50, 52 and 54 are shown as being of the same size and shape. Consequently any pressure provided by the side walls of one of those channels on an orientation probe in a manner which causes that probe to be "rigidly affixed" to the channel would clearly interfere with the free movement of an therapeutic probe of similar size passing through another of the guide channels, thus rendering the apparatus incapable of being used and operated as described in claim 37. Of course it might be argued that an apparatus might be designed in which the size or shape of the therapeutic probes is accurately designed to be very slightly different from that of the orientation probe, and that such an arrangement of probes might be used within Zurinski's guide channels in the manner described in claim 37, yet it is certainly clear that no such design and no such contemplated use are mentioned or suggested by Zurinski. Consequently, Zurinski's device, absent this additional design consideration, cannot be described as anticipating the device defined in claim 37. Applicant submits that claim 37 and claims dependent thereon should therefore be considered allowable over Zurinski.

Claim Rejections – 35 U.S.C. §103

The Examiner has rejected claims 7-8 and 45-46 as being unpatentable over Downey et al. as applied to claims 1 and 37, in view of Zvuloni et al (U.S. Patent No. 6,706,037). Applicant believes that the current amendments to claims 1 and 37, as discussed above, overcome this rejection, which is based on the original form of those claims.

Similarly, the Examiner has rejected claims 13-15, 31, 51-52, and 68 as unpatentable over Downey et al. as applied to claims 1 and 37, in view of Schatzberger (U.S. Patent No. 6,142,991). Applicant believes that the current amendments to claims 1 and 37, as discussed above, overcome this rejection, which is based on the original form of those claims.

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Similarly, the Examiner has rejected claims 30 and 67 as unpatentable over Downey et al. as applied to claims 1 and 37, in view of Whitmore III et al. (U.S. Patent No. 5,931,786), and has rejected claims 35-36 as unpatentable over Downey et al. as applied to claims 1 and 37, in view of Morra et al. (*Choices*). Applicant believes that the current amendments to claims 1 and 37, as discussed above, overcome these rejections, which are based on the original form of those claims.

Similarly, the Examiner has rejected claim 41 as unpatentable over Downey et al. as applied to claims 38, in view of Kelly et al (U.S. Patent No. 5,483,961) and in view of Migdal. Claim 38 depends from claim 37, currently amended. Applicant believes the current amendment of claim 37 overcomes this rejection.

The Examiner has also rejected claims 1, 9-12, and 32-33 as being unpatentable over Zurinski et al (U.S. Patent No. 4,542,747) in view of Downey et al. The Applicant submits that the current amendments to claim 1, and his arguments with regard to Zurinski presented above, suffice to overcome these rejections.

In view of the above amendments and remarks it is respectfully submitted that the pending claims as here amended are now in condition for allowance. A prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,

Martin D. Moynihan
 Registration No. 40,338

Date: September 10, 2009

Enclosure:

- Petition for Extension of Time (1 Month);
- Letter to Chief Draftsman;
- 1 Sheet of Annotated Marked-Up Drawing;
- Formal Drawing Transmittal Sheet; and
- Complete Set of Replacement Drawing Sheets.

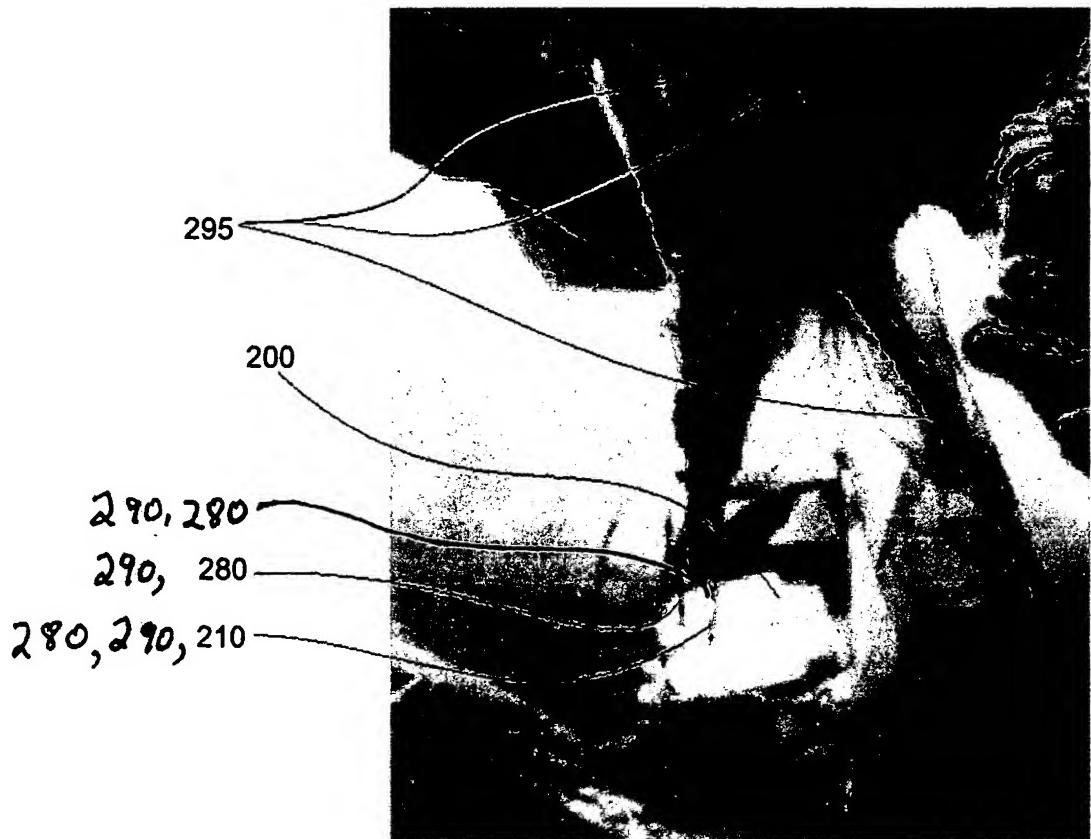


FIG. 11